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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,494	09/06/2005	Louis Schofield	18611	4482
7590 10/05/2010				
Leopold Presser Scully Scott Murphy & Presser 400 Garden City Plaza Suite 300 Garden City, NY 11530			EXAMINER SWARTZ, RODNEY P	
			ART UNIT 1645	PAPER NUMBER
			MAIL DATE 10/05/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,494

**Applicant(s)**

SCHOFIELD, LOUIS

**Examiner**

Rodney P. Swartz, Ph.D.

**Art Unit**

1645

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 8, 15-22, 28, 33, 38-42, 49, 50, 52-56, 60-62, 66-68 and 72-81 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB006)  
Paper No(s)/Mail Date 4/2010.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ ~~Notes of Informal Patent Application~~
- 6) ☐ Other: \_\_\_\_\_.

#### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 26 April 2010 has been entered.

The information disclosure statement (IDS) submitted on 26 April 2010 has been considered by the examiner.

2. Claims 1, 8, 15-22, 28, 33, 38-42, 49, 50, 52-56, 60-62, 66-68 and 72-81 are pending and under consideration.

#### **Priority Statement**

3. A reference to provisional application 60/398,607, 07/26/2002, must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e), 120, 121, or 365(c). See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications.

Until said reference, *supra*, is inserted into the specification, the priority date of the instant application is 07/25/2003.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 8, 15-22, 28, 33, 38-42, 49, 50, 52-56, 60-62, 66-68 and 72-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Seeberger et al (U.S. Pub. No. 2006/00889330).

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

The claims are drawn to a method of eliciting or inducing an immune response to a parasite (*Plasmodium*) comprising administering an immunogenic composition which comprises the inositolglycan domain portion of GPI, which inositolglycan domain portion comprises insufficient lipidic domain to induce or elicit said immune response, and which has a terminal inositol-phosphoglyceron substituted with a positively or negatively charged moiety.

Seeberger et al teach the claimed compositions and methods of inducing an immune response to a parasite, e.g., *Plasmodium* (Abstract; paragraphs 0013-035).

5. Claims 1, 8, 15-22, 28, 33, 38-42, 49, 50, 52-56, 60-62, 66-68 and 72-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Schofield et al (*Nature*, Vol. 418, pages 785-789, 15August2002).

The claims are drawn to a method of eliciting or inducing an immune response to a parasite (*Plasmodium*) comprising administering an immunogenic composition which comprises the inositolglycan domain portion of GPI, which inositolglycan domain portion comprises

insufficient lipidic domain to induce or elicit said immune response, and which has a terminal inositol-phosphoglyceron substituted with a positively or negatively charged moiety.

Schofield et al teach the claimed compositions and methods of inducing an immune response to a parasite, e.g., *Plasmodium* (Figure 1; page 785-788).

### **Conclusion**

6. Claims 1, 8, 15-22, 28, 33, 38-42, 49, 50, 52-56, 60-62, 66-68 and 72-81 are rejected.
7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's Supervisor, Larry Helms, at (571)272-0832.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

October 1, 2010